



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/624,154	07/24/2000	Peter Godlewski	16166-001800US	5073

20350 7590 03/31/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 03/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.

09/624,154

Applicant(s)

Godlewski et al

Examiner

Andrew J. Fischer

Art Unit

3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 6, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 31-35 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 6, 2003 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 3627

DETAILED ACTION

Acknowledgments

1. The amendment filed January 6, 2003 (Paper No. 12) is acknowledged. Accordingly, claims 1-15 and 31-35 remain pending.

Restriction & Election of Species

2. Applicants' election without traverse of Invention I (claims 1-15 and 31-35) in Paper No. 8 is acknowledged.
3. Applicants' election without traverse of Species I represented by figure 1 (claims 1-15 and 31-35) in Paper No. 8 is also acknowledged.

Drawings

4. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on January 6, 2003 (Paper No. 13) have been approved by the Examiner.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 3627

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

6. Claims 1, 3, and 31-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Sone (U.S. 6,204,763 B1, hereinafter "Sone"). Sone discloses the following: providing a plurality of dispensing units (storage receptacle 11) that each hold a plurality of each of multiple distinct items (e.g. milk, toilet paper, paper towels, and canned food as showing in figure 2), the units have processor and memory (inherent in computer 26); periodically sending restocking information from the dispensing units (an item is added to the list after its been in the refrigerator for a predetermined length of time or an order is triggered if the quantity is below a predetermined threshold) over a network to a server computer (24) wherein the restocking information includes restock quantity for each item (inherent); aggregating the restock quantities over the plurality of dispensing units for each of the multiple distinct items (occurs on the user's bill, e.g. if milk was delivered twice, the user would have milk delivery twice on their bill; alternatively, the four (4) toilet paper rolls as shown in figure 2); generating the ordering information (quantity to be ordered) based on the aggregate restocking information (the 4 rolls of toilet paper; its impractical to supply a single roll); electronically sending the ordering information to one or more supplier computers to order items to be restocked within the dispensing units (inherent); generating ordering information (for vendor purposes) *using* the sever computer (without the server computer, the vendors would not have ordering information to fill the order); determining supplier

Art Unit: 3627

information (which supplier or vendor furnishes a given product); accessing the hosted procurement application (the computer program running on computer 26) to view the ordering information on a display screen of a user computer (touch screen, see column 5, ~lines 62+) with ordering pages (inherent); the information is sent to a business portal computer (inherent in the multiple vendors) using a purchase order number (inherent in the order number); sending advance shipping notice (e.g. requesting delivery of milk on ever Saturday afternoon); an electronic invoice is sent (inherent since how else would the household's purchases be tracked and billed?).

7. It is the Examiner's principle position that Sone inherently discloses a method for supplying items in a plurality of homes (or households).

a. Because Sone discusses prior art systems in "commercial establishments" yet not appreciated in the home environment (column 2, ~ lines 8-13), Sone inherently discloses the use of the system in a plurality of homes. Additionally evidence of the inherency is that it would be impractical for a vendor to provide the service to a single home.

b. Moreover, Sone column 2, ~ lines 33-35 states, "More particularly, the present invention comprises *a household* consumable item automatic replenishment system and method . . . [Emphasis added.]" "It is well settled that the term 'a' or 'an' ordinarily means one or more." *Tate Access Floors Inc. v. Interface Architectural Resources Inc.*, 279 F.3d 1357, 1370, 61 USPQ2d 1647, 1657 (Fed. Cir. 2002). Therefore, "a household" noted above is interpreted to mean one or more households.

Art Unit: 3627

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3, and 31-34 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Sone.¹ It is the Examiner's principle position that use of the automatic replenishment system in multiple homes (or households) is inherent in Sone and therefore anticipated as noted above.

Alternatively, if not inherent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Sone to include the system in multiple homes. Such a modification would have made system profitable for the vendors and delivery persons since they would never make money if the system was for a single home.

Furthermore, the placement of the automatic replenishment system in multiple homes is merely duplicating an easily delineated and expressly described embodiment in Sone. Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. See MPEP §2144.04 VI *B* or *In re Harza*, 47 CCPA 771, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

¹ See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

Art Unit: 3627

10. Claims 2, 4-15, and 35 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Sone in view of Salvo et. al. (U.S. 6,341,271)(“Salvo”). Sone discloses as discussed above but does not directly disclose receiving the request *using the server computer* to obtain the quantities of items to be restocked. Additionally, Sone does not disclose much in terms of the vendor side of the operations in the disclosed system.

Salvo directly teaches initiating the request by the vendor (vendor managed inventory). Salvo’s vendor managed inventory system has the vendor initiating the request (column 9, ~ lines 37-65); generating payment (at 155); and permitting manual selection of suppliers and manufactures. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Sone as taught by Salvo and include various aspects of Salvo’s vendor managed inventory system to the vendor side of Sone. In particular, this would include Salvo’s vendor management tools (some of which are noted above in the cited passage). Such a modification would have further reduced delays, costs of ordering, and inventory turn around times.

Additionally, the modification would have helped synchronize inventory ordering and delivery so that food-related items are not out of stock in the home and that perishable goods spend as little as time as possible in transit. For example, suppose milk inventory becomes low in a particular home every Saturday morning because children in the home are having cereal with milk while watching cartoons. Using the vendor’s historical trend analysis tool as implemented in Salvo, automatic ordering and subsequent delivery of milk could occur every Saturday afternoon.

Art Unit: 3627

11. The Examiner notes that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. Specifically, after receiving notice in the previous Office Action² of the Examiner's position that lexicography is *not* invoked, Applicants have elected *not* to point out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants have failed to argue lexicography *is* invoked). To support the Examiner's position that Applicants are not their own lexicographer, it is the Examiner's factual determination that not only have Applicants failed to point to definitional statements in their specification or prosecution history, Applicants have also failed to point to a term or terms in a claim with which to draw in those statements.³ Finally and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation⁴ to be their own lexicographer.⁵ Accordingly and for due process purposes, the Examiner gives notice that for

² See the Examiner's previous Office Action mailed September 5, 2002, Paper No. 9, Paragraph No. 12.

³ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, at the very least, point to a term or terms in the claim with which to draw in those statements." *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁴ See again the Examiner's previous Office Action, Paper No. 9, Paragraph No. 12.

⁵ The Examiner's request on this matter was reasonable on at least two separate and independent grounds: first, the Examiner's request was simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the

Art Unit: 3627

the remainder of the examination process and unless expressly noted otherwise by the Examiner, the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁶ The Examiner now relies heavily and extensively on this interpretation.⁷ See e.g. *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1381, 62 USPQ2d 1865, 1877 (Fed. Cir. 2002) (“Because the patentee has not chosen to be his own lexicographer in this instance, [the claimed element] should carry its ordinary meaning”)(Clevenger, J. dissenting in part). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

12. Functional recitations using the word “for” and “to” (e.g. “for supplying items to a plurality of dispensing units” as recited in claim 1 and “to permit” as recited in claim 33) have been given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps.

requirements were reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed March 16, 2003).

⁶ See also MPEP §2111 and §2111.01; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc).

⁷ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

Art Unit: 3627

See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

13. It is the Examiner's factual determination that all claimed limitations in the examined claims have been considered and are either disclosed or inherent in the references as discussed above. Furthermore, the inherent features are established by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)). The preceding discussion regarding the standard for claim rejections applies to all examined claims currently pending.

Conclusion

14. Applicants' amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 3627

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph antecedent basis and indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as described above.

Art Unit: 3627

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Brown et. al. (U.S. 6,430,541 B1); Rosenberg et. al. (U.S. 6,418,416 B1); Horne et. al. (U.S. 5,091,713); and Bianco (U.S. 5,047,614).

17. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.


18. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their "Remarks" (Paper No. 12, pages 9-12) traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied⁸, the Examiner respectfully requests Applicants *in their next properly filed response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have *any* questions regarding the Examiner's positions or

⁸ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.

Art Unit: 3627

have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.


ANDREW J. FISCHER
PATENT EXAMINER


Kenneth R. Rice
Primary Examiner

AJF
March 23, 2003